

REMARKS

Applicants respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. A single ground of rejection is outstanding (for obviousness), which Applicants believe would be clearly obviated by the amendment to claim 1 and cancellation of claims 35-36 as set forth herein.

I. STATEMENT REGARDING INTERVIEW UNDER 37 C.F.R. § 1.133(B)

Applicants' Representative thanks Examiner Q. Mi for the helpful and courteous interview of December 1, 2009. During the interview, Applicants' Representative proposed the amendment presented herein, to introduce into claim 1 the limitations of claim 36. The examiner agreed that the subject matter of claim 36 falls within the scope of the elected Group (composition) and is thus not properly considered withdrawn from consideration. The substance of the interview is set forth in more detail below.

II. DISPOSITION OF CLAIMS

Claim 1, 14-23, and 26-36 are pending in the application. Claims 35-36 are requested to be canceled. Claims 15-16, 23, and 26-32 are withdrawn. Upon entry of the amendments presented herein, claims 1, 14, 17-22, and 33-34 would be under examination.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

III. ELECTED SUBJECT MATTER; REJOINDER OF COMPOSITION CLAIMS

Claim 1 as presently amended reflects subject matter elected as Group I in response to the Restriction Requirement dated January 9, 2008. The amendment introduces limitations requiring, inter alia, glycerol palmitostearate. Glycerol palmitostearate is a species of "fatty acid mono-, di- or triglycerides", the latter having been provisionally elected for search purposes as the elected species of "lipophilic additive" in response to the Restriction Requirement. See Response to Restriction Requirement filed February 11, 2008 (electing "(i) mono-, di, and triglycerides fatty acid of claim 14, (ii) soya oil of claim 19 and (iii) green tea").

Thus, claim 1 as amended would be properly considered elected subject matter.

For the same reasons, Applicants request rejoinder of composition claims 15-16, 23, and 26-27. Each of these claims falls within the scope of the species elected by Applicants.

Claims 15-16 recite glycerol palmitostearate. Claim 23 refers to an additional “physiologically active component” beyond the recited components of claim 1. Finally, claims 26-27 each recite the species elected by Applicants. Specifically, Applicants elected “(i) mono-, di, and triglycerides fatty acid of claim 14, (ii) soya oil of claim 19 and (iii) green tea” (see Response to Restriction Requirement). Claims 26-27 recited glycerol palmitostearate (as mono-, di, and triglycerides fatty acid), soya oil, and green tea.

In particular, Applicants request treatment of the presently claimed subject matter as elected, because the scope is immediately allowable, as explained below.

IV. OBVIOUSNESS REJECTION

The claims stand rejected as obvious over the combination of US 5,273,754 (“Mann”), US 4,393,049 (“Horrobin”), US 2002/0192308 (“Mamana”), and US 6,069,147 (“Williams”). Applicants request withdrawal of the obviousness rejection for the reasons that follow.

A. The Claims Are Commensurate In Scope With The Unexpected Results

Applicants have amended claim 1 to recite “wherein the composition comprises beeswax and glycerol palmitostearate, wherein the weight ratio of beeswax represents approximately 5% by weight based on the total composition, and wherein the weight ratio of glycerol palmitostearate represents approximately 5% by weight based on the total composition”.

In the final Office Action, the Office maintained its position that the data showing unexpected results (specification, page 11) is not commensurate in scope with the claims (final Office Action, page 14). The Office acknowledged, however, in the final Office Action (paragraph bridging pages 14-15) and in the Examiner Interview of December 1, 2009, that the test data would necessarily be commensurate in scope to the limitations now inserted into claim 1, i.e., “approximately 5% by weight based on the total composition” each of beeswax and glycerol palmitostearate.

Claim 1 has been correspondingly amended. Accordingly, the obviousness rejection is thereby obviated.

B. Applicants Do Not Concede Prima Facie Obviousness

Applicants respectfully traverse the obviousness rejection of the full scope of claim 1 prior to this amendment, for the reasons previously presented. Essentially, Applicants reiterate that the art of record fails to properly establish prima facie obviousness. Applicants have proposed the amendment herein to further prosecution, reserving the right to pursue the full scope of claim 1 in a continuation application if desired.

Applicant considers the invention as claimed nonobvious for the reasons summarized below:

- Mann teaches that capsaicin may be useful for obesity treatment but acknowledges a tolerance problem due to the burning sensation in the stomach. To solve this problem, a “cooling carminative substance” such as menthol or herbal extracts are added. Such “cooling carminative substance” is absent from the composition of the present patent application.
- Horrobin teaches that gamma-linolenic acid, which is a more tolerant form (than linoleic acid when used with fats and oils), may be useful for treating obesity. Gamma-linolenic acid poly-unsaturated fatty acid is not recited in the composition claims of the present application. Therefore the use of linoleic acid, and thus sunflower oil and/or corn oil, is unobvious in the present invention, which uses other lipophilic additives (such as beeswax).
- Mamana teaches that green tea leaves or extracts may be useful in the treatment of obesity. However, green tea leaves or extracts can be used as additional active principles which are not the subject matter of the main independent claim 1.
- Williams teaches that PEG may be used as a suspending aid for liquid formulations containing moxonidine. Williams does not teach that PEG may be used to diminish the burning sensation induced by capsaicinoids or other thermogenesis inducing compounds.

Nothing in the prior art cited would suggest the idea that the tolerance problem (burning sensation in the stomach) of using capsaicin could be solved by using an oil-based formulation containing common vegetable oil with a lipophilic additive. From the teaching of the references, it is therefore apparent that one of the ordinary skills in the art would not have had reasonable expectation of success in producing the claimed invention. Thus the invention as a whole is not prima facie obvious over the references.

For all the reasons provided above, the obviousness objection should be withdrawn.

CONCLUSION

Applicants request entry of this Amendment because it raises no new issues, would not require further search, and would result in allowance. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

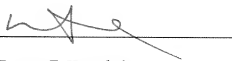
If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date

7-DEC-2009

By



FOLEY & LARDNER LLP

Customer Number: 22428

Telephone: (202) 672-5300

Facsimile: (202) 672-5399

Rouget F. Henschel

Attorney for Applicants

Registration No. 39,221